

Attorney Docket No.  
COE-566

PATENT APPLICATION  
Serial No. 10/715,430

### REMARKS

Applicants appreciate Examiner's thorough review of the application. The full claim set as amended in the previous response has been included for Examiner's convenience in reviewing this response. Applicants have amended Claims 1, 2, 5, and 6  
5 herein and canceled Claim 4 herewith. No new material has been added. Reconsideration of the application is respectfully requested.

To assist in reviewing Applicants' response: where Applicants have quoted Examiner's office action, the quoted material is single-spaced and indented and Applicants' response to Examiner's concerns is in bold print.

10 Under "Election Restrictions" of the office action, Examiner states:

In response to Applicants' comment that the "Examiner may have mistakenly included the phrase "there being no allowable generic or linking claim" under the comments for Claims 16-35 and it should have been under comments to Claims 10, 11, and 13-15," the examiner notes that the phrase  
15 "there being no allowable generic or linking claim" should have been in the statement withdrawing for both claims 16-35 and claims 10, 11, and 13-16. The phrase is part of a form paragraph that examiners are given for their use in withdrawing claims in response to both an election from a restriction requirement and an election from an election of species requirement (i.e.,  
20 the withdrawal of claims 16-35 (non-elected invention) being in response to an election from a restriction requirement and the withdrawal of claims 10, 11, and 13-15 (non-elected species) being in response to an election from an election of species requirement).

25 Applicants appreciate Examiner taking the effort to further explain the restriction requirement.

Under "Claim Objections of the office action, Examiner states:

Claim 1 is objected to because of the following informalities:

(1) claim 1, line 22, the recitation of "the step of emplacing said  
30 panels" should be change to – the step of placing said panels—for proper antecedent basis (see line 11-14) so there is no confusion with the step of emplacing said topmost section recited in lines 18-21.

Appropriate correction is required.

35 Applicants have amended Claim 1 herein to address Examiner's concern.

Under "Claim Rejections – 35 U.S.C. §112" of the office action, Examiner quotes  
35 U.S.C. § 112, 2<sup>nd</sup> paragraph, and states:

Attorney Docket No.  
COE-566

PATENT APPLICATION  
Serial No. 10/715,430

Claims 1-9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5 Claim 1, line 3-5, the recitation of "a porous topmost section emplaced on top of said barrier, said topmost section being of the same class of porous material as the porous material immediately below said barrier" is vague, indefinite, and confusing for the following two reasons.

10 First, the recitation of "being of the same class of porous material" is not understood. The examiner notes that it has not been defined in the specification what "being of the same class of porous material" means. One of ordinary skill in the art could find two porous materials to be of the same class for different reasons (i.e., same class With respect to degrees of hardness, or the same class With respect to degree of porosity, etc.). If  
15 Applicant is trying to claim that both the top and bottom layers above and below the barrier, respectively, is the same porous material (e.g., concrete), then he should clearly recite this.

20 Second, the recitation of "the porous material immediately below said barrier" is vague, indefinite, and confusing as lacking antecedent basis because although the barrier has been recited to be "embedded within porous material" in line 2, this does not establish that there is porous material immediately below said barrier.

Clarification is required.

25 Applicants have amended Claims 1, 2, 5 and 6 herein and canceled Claim 4 herewith to address Examiner's concerns. The claims now specify concrete as the porous material.

Under "Claim Rejections - 35 U.S.C. 102" of the office action, Examiner quotes  
30 35 U.S.C. § 102(b) and states:

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Dahlander (U. S. patent no. 2,036,123).

35 As to claim 1, Dahlander discloses a method of implementing a barrier (3) to fluid flow in at least one direction, said barrier (3) embedded within porous material (concrete 1 and flooring 2 (see page 1, second column, wherein the flooring is anyone of "wood, rubber, linoleum, cork or the like" which are all considered to be porous material) incorporating a porous topmost section (2) emplaced on top of said barrier (3), said topmost section (2) being of the same class of porous material as the porous material  
40 (1) immediately below said barrier (3), said topmost section (2) having a topmost surface suitable for use by wheeled traffic, comprising:

applying at least one layer of an adhesive material (4), said at one layer of adhesive material (4) to include a topmost layer of said adhesive material (4), to an entire first surface of said porous material (1), said

Attorney Docket No.  
COE-566

PATENT APPLICATION  
Serial No. 10/715,430

applying done to said first surface prior to emplacing said topmost section (2);

placing multiple panels (sheet metal strips 10, 10,...) incorporating at least one layer of non-porous material (metal – see page 1, second column, lines 14-26) upon said topmost layer of said adhesive material (4).

overlapping edges of said panels (10, 10,...) with edges of said panels (10, 10,...) placed adjacent thereto (see Figs. 2, 4 and 5), wherein said panels (10, 10,...) completely cover said topmost layer of said adhesive material (4):

sealing all said overlapped edges (see either Fig. 4 and page 2, first column, lines 7-21 or Fig. 5 and page 2, first column, lines 22-31); and

emplacing at least one layer of material (2) comprising said topmost section (2) upon said panels (10, 10,...) such that each said panels (10, 10,...) are confined below said topmost section (2) and above said topmost layer of said adhesive material (4),

wherein the step of emplacing said panels (10, 10,...), the step of sealing said overlapped edges of said panels (10, 10,...), and the step of emplacing said topmost section (2) completes implementation of said barrier (3).

The examiner notes that the recitation said barrier is "embedded within porous material incorporating a porous topmost section emplaced on top of said barrier, said topmost section being of the same class of porous material as the porous material immediately below said barrier" is deemed to be met by Dahlander since it is not clear what is meant by "same class of porous material" (see 35 U.S.C § 112, second paragraph rejection above). Therefore, the examiner deems the porous concrete bottom layer (1) to be within the same class of porous material as the porous wood, rubber, linoleum, cork or the like material of the topmost layer (2).

The examiner notes that the recitation of the topmost section having a topmost surface "suitable for use by wheeled traffic" is a statement of intended use and as such the reference only need be capable of performing such intended use. In the present case, "wheeled traffic" could be anything such as a bike or baby buggy and therefore, it is the examiner's position that Dahlander is capable of performing the intended use.

As to claim 2, Dahlander discloses the method of claim 1 as discussed above, and Dahlander also discloses that said barrier (3) employs non-porous material (sheet metal, preferably copper) being any one selected from the group consisting of: a metal, a metal alloy, a steel alloy, a stainless steel, a composite material, a composite material containing at least some metal, and combinations thereof.

As to claim 3, Dahlander discloses the method of claim 1 as discussed above, and Dahlander also discloses that said barrier (3) employs non-porous material (sheet metal, preferably copper) comprising at least in part a first metal.

As to claim 4, Dahlander discloses the method of claim 1 as discussed above and Dahlander also discloses that the porous material

Attorney Docket No.  
COE-566

PATENT APPLICATION  
Serial No. 10/715,430

(concrete 1 and wood, rubber, linoleum, cork or the like 2) that encloses said barrier (3) comprising at least in part concrete.

Applicants have amended Claim 1 upon which Claims 2 and 3 depend to indicate that the barrier being implemented is placed between concrete layers. The  
5 *Dahlander* patent nowhere indicates this alternative. Further, Applicants have canceled Claim 4 herewith as being redundant in view of the amendment to Claim 1 herein.

For Applicants' invention, the "topmost layer of concrete (second layer" (as herewith claimed in amended claim 1) is the same type of material, i.e., concrete, as  
10 the first layer. (See, for example, p. 7, lines 15-18). Applicants' invention provides a monolithic structure and, in addition to serving as a moisture barrier, Applicants' barrier serves as reinforcing structure to the monolith, much as a metal screen or rebar does. Further, this reinforcing function occurs near the top of the monolith at the location where it is most helpful to address external stress on the monolith.

15 Both Examiner's 35 U.S.C § 112 and § 102 rejections have been addressed by amendments herein that now put the claims in condition for allowance.

Under "Claim Rejections – 35 U.S.C. 103" of the office action, Examiner quotes 35 U.S.C. § 103(a) and states:

20 Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Dahlander* (U. S. patent no. 2,036, 123) in view of *Bean et al.* (U. S. patent no. 6,286,279).

As to claim 5, *Dahlander* discloses the method of claim 4 as discussed above.

25 *Dahlander* fails to explicitly disclose that the step of employing said adhesive material comprises at least in part a thin set mortar at a thickness of about 6 mm (0.25 inch).

30 *Bean et al.* teaches the use of an adhesive layer (18) of a Portland cement-based adhesive to bond a steel foil (12) to concrete (C). *Bean et al.* does not explicitly disclose (sic) that the adhesive layer is about 6 mm (.24 inch).

35 However, it is well settled that changes in size and/or proportion between the invention and the prior art do not constitute a patentable difference. See *In re Rose*, 220 F. 2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating

Attorney Docket No.  
COE-566

PATENT APPLICATION  
Serial No. 10/715,430

5 to the size of the package were not sufficient to patentability distinguish over the prior art). *In re Rinehart*, 531 F. 2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F. 2d at 1053, 189 USPQ at 148.). Further, in *Gardner v. TEC Systems, Inc.*, 725 F. 2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

10 Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made of (sic, to) modify the method of implementing a barrier to fluid of Dahlander by replacing the adhesive of Dahlander (waterproof adhesive, such as asphalt layer 4 – see page 1, second column, lines 28-29) of Dahlander with the Portland cement-based adhesive as taught by Bean et al. in order to form a bond between the concrete and metal that does not degrade in the presence of moisture and alkalinity, and to make the adhesive layer 6 mm (0.25 inches) thick would have constituted a further obvious expedient to one having ordinary skill in the art at the time the invention was made since it is well founded that merely changing dimensions is not unobvious (see *Brunswick Corporation v. Champion Spark Plug Company*, 216 USPQ 1 (CA 7, 1982).

25 **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlander (U. S. patent no. 2,036, 123) in view of Burgess (U. S. patent no. 1,986,999).**

As to claim 6, Dahlander discloses the method of claim 1 as discussed above.

30 Dahlander fails to explicitly disclose that the step of applying said topmost section is comprised at least in part of concrete at a thickness of about at least 2.5 cm (1.0 inch).

35 Burgess teaches a flooring structure in which corrugated metal plates (11) are overlapped (see at 15, 16 in Fig. 1) and a concrete layer (20) is then emplaced to form the floor surface. Burgess fails to explicitly disclose that the concrete layer is at least 2.5 cm (1.0 inch) thick.

40 However, it is well settled that changes in size and/or proportion between the invention and the prior art do not constitute a patentable difference. See *In re Rose*, 220 F. 2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentability distinguish over the prior art). *In re Rinehart*, 531 F. 2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being soaked up, if such were the case, would not establish patentability in a claim to an old

Attorney Docket No.  
COE-566

PATENT APPLICATION  
Serial No. 10/715,430

process so scaled." 531 F. 2d at 1053, 189 USPQ at 148). Further, in *Gardner v. TEC Systems, Inc.*, 725 F. 2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made of (sic, to) modify the method of implementing a barrier to fluid of Dahlander by replacing the flooring material of Dahlander with a concrete layer as taught by Burgess in order to provide a sturdier wear surface, and to make the concrete layer 2.5 cm (1 inch) thick would have constituted a further obvious expedient to one having ordinary skill in the art at the time the invention was made since it is well founded that merely changing dimensions is not unobvious (see *Brunswick Corporation v. Champion Spark Plug Company*, 216 USPQ 1 (CA 7, 1982).

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlander (U. S. patent no. 2,036, 123) in view of Schirmer (U. S. patent no. 4,155,209).

As to claim 7, Dahlander discloses the method of claim 1 as discussed above.

Dahlander fails to explicitly disclose that the step of sealing said overlapped edges is done at least in part by applying a continuous bead of at least one sealant along the entire length between each said overlapped edge, wherein said sealant remains flexible upon curing.

Schirmer discloses a fluid-sealed sheet metal joint wherein the step of sealing said overlapped edges is done at least in part by applying a continuous bead of at least one sealant along the entire length between each said overlapped edge, wherein said sealant remains flexible upon curing (see col. 3, lines 18-49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made of (sic, to) modify the method of implementing a barrier to fluid flow of Dahlander by replacing the sealant (sealing wire (11) or sealing ribbon 14) of Dahlander with the flexible room temperature vulcanizing (RTV) sealant taught by Schirmer in order to provide a waterproof joint that will remain so even after being subjected to numerous freeze and thaw cycles (see col. 1, lines 16-25).

As to claim 8, Dahlander in view of Schirmer discloses the method of claim 7 as discussed above, and Schirmer also discloses that a room temperature vulcanizing (RTV) sealant (see col. 3, lines 18-49) is employed as said at least one sealant.

Attorney Docket No.  
COB-566

PATENT APPLICATION  
Serial No. 10/715,430

Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlander (U. S. patent no. 2,036, 123).

As to claim 9, Dahlander discloses the method of claim 1 as discussed above, and Dahlander also discloses that the step of providing said panels as at least one plate.

Dahlander fails to explicitly disclose that the at least one plate has a total thickness less than about 6 mm (0.25 inch).

However, it is well settled that changes in size and/or proportion between the invention and the prior art do not constitute a patentable difference. See *In re Rose*, 220 F. 2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentability distinguish over the prior art). *In re Rinehart*, 531 F. 2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being soaked up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F. 2d at 1053, 189 USPQ at 148.). Further, in *Gardner v. TEC Systems, Inc.*, 725 F. 2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Therefore, to make the at least one plate have a total thickness less than about 6 mm (.25 inch) would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made since it is well founded that merely changing dimensions is not unobvious (see *Brunswick Corporation v. Champion Spark Plug Company*, 216 USPQ 1 (CA 7, 1982).

As to claim 12, Dahlander discloses the method of claim 1 as discussed above, and Dahlander also discloses that (sic) the step of providing the panels as at least one foil.

However, Dahlander fails to explicitly disclose that the at least one foil has a thickness less than about 1 mm (40 mil).

However, it is well settled that changes in size and/or proportion between the invention and the prior art do not constitute a patentable difference. See *In re Rose*, 220 F. 2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentability distinguish over the prior art). *In re Rinehart*, 531 F. 2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being soaked up, if such were the case, would not establish patentability in a claim to an old

Attorney Docket No.  
COE-566

PATENT APPLICATION  
Serial No. 10/715,430

5 process so scaled." 531 F. 2d at 1053, 189 USPQ at 148). Further, in *Gardner v. TEC Systems, Inc.*, 725 F. 2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

10 Therefore, to make the at least one plate be a foil (i.e., very thin sheet metal) having a total thickness less than about 1 mm (40 mils) would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made since it is well founded that merely changing dimensions is not unobvious (see *Brunswick Corporation v. Champion Spark Plug Company*, 216 USPQ 1 (CA 7, 1982).

15 As noted above, Applicants have herewith amended Claim 1 to put it in condition for allowance and Claims 5-9 and 12 depend on Claim 1, either directly or indirectly.

20 Claim 1 has been distinguished from the cited art by this amendment and thus dependent claims 5-9 and 12 are also. Applicants reference discussion on 35 U.S.C § 103 (a) requirements as provided in their response to the first Office Action and incorporate them herein.

Under "Response to Arguments" of the office action, Examiner states:

Applicants' arguments filed 12 January 2006 have been fully considered but they are not persuasive.

25 With respect to the 35 U.S.C § 102(b) rejection of claims 1-4, Applicants argue that Dahlander does not disclose that his barrier is enclosed by material of the same class above and below the barrier. The examiner disagrees because Dahlander discloses a barrier (metal sheet layer 3) having a porous concrete layer (1) below it and a porous material layer 30 (flooring 2 comprised of wood, rubber, linoleum, cork or the like) above it. Nowhere in Applicant's specification does it define what is meant by "same class" of porous material. Further, one of ordinary skill in the art would not understand what is meant by "same class" of porous material because porous materials could be of the "same class" for different reasons. For 35 instance, porous material could be classed together on the basis of porosity and this class of porous materials would be different from porous materials that were classed together based upon some other property. Without a definition of what is meant by (sic, by) "same class" of porous material (i.e., based upon what property), this limitation is vague, indefinite, and



Attorney Docket No.  
COE-566

PATENT APPLICATION  
Serial No. 10/715,430

confusing so that the structure disclosed by the Dahlander reference is deemed to meet the limitation.

As discussed above With respect to the 35 U.S.C § 102(b) rejection of this Office Action , Applicants have amended Claims 1 and 2 herein and canceled Claim 4 herewith to address Examiner's concern. This action makes the above argument moot, since the "vague, indefinite and confusing" terms and phrases are no longer in the claims.

Continuing in this section, Examiner states:

With respect to the 35 U.S.C § 103(a) rejections involving Dahlander in view of Bean et al., Dahlander in view of Burgess, Dahlander in view of Schirmer, and Dahlander alone, Applicants have alleged that the "Examiner has provided no evidence on motivation to combine any of the cited patents with Dahlander." The examiner disagrees as she has explicitly stated a motivation to combine the secondary reference with Dahlander for each of the 35 U.S.C § 103(a) rejections.

Applicants have amended the independent Claim 1 making this argument moot. Any inkling of a motivation to combine the cited references with Dahlander no longer exists, if it ever did, due to the amendments to the claims made herein.

To establish a *prima facie* case of obviousness, there must be some motivation to combine references, with a reasonable expectation of success, to teach each and every claimed limitation. MPEP § 2143. The limitation of a concrete first layer upon which a barrier, an adhesive and a concrete top layer are added as claimed in Claim 1 amended herein is not taught by Dahlander nor is there motivation in any of the cited references to include these limitations. To be proper, the asserted combination of references can neither render the prior art unsatisfactory for its intended purpose nor change the principle of operation of a reference. MPEP § 2143.01.

As discussed above, Dahlander fails to teach each and every element recited in amended Claim 1. The Examiner does not assert that Bean teaches any of the claimed elements missing from Dahlander, relying on Bean only to teach the use of an adhesive of the same type used by Applicants, i.e., a Portland cement-based

Attorney Docket No.  
COE-566

PATENT APPLICATION  
Serial No. 10/715,430

adhesive. Applicants have amended Claim 1 herewith to indicate that concrete is employed in the final top coating as in the underlayment. Nowhere in any of the cited references is this limitation. Accordingly, the asserted combination of references fails to teach each and every limitation of the claimed invention, and  
5 therefore cannot properly form the basis of a rejection under 35 U.S.C. § 103.

Additionally, there must exist a basis in the art for combining or modifying references.

10 Obviousness cannot be established by combining the teachings of prior art to produce the claimed invention, *absent some teaching, suggestion or incentive* supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). (emphasis added)

15 A 35 U.S.C. § 103 rejection presumes that differences exist between the subject matter of appellants' claims and those of the prior art. Else a rejection under §102 would apply. Thus, the examiner must cite something in the prior art that suggests in some way a modification of a particular reference or a combination with another reference in order to arrive at the claimed invention. Examiner's  
20 reference to *Dahlander* in view of *Bean* does not do this as discussed below.

Although *Cable Elec. Prods. Inc. v. Genmark, Inc.*, 770 F. 2d, 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985) holds that a "suggestion to modify the art to produce the claimed invention need not be expressly stated in one or all of the references to show obviousness," there must be at least some suggestion that can be  
25 read "between the lines." This suggestion must be suitable for a person of ordinary skill in the art, at the time the invention was made, to act upon. "Rather, the test is whether the combined teachings of the prior art, taken as a whole" suggest the modifications to the person of ordinary skill in the art. *In re Napier*, 55 F. 3d 610, 34 USPQ 2d 1782 (Fed. Cir. 1995). Should those "skilled in the art" act upon the  
30 suggestions given "between the lines" in *Dahlander* in view of *Bean* the logical suggestion would have been to produce Applicants' invention using a different material for the top layer, not the same material as is in the underlayment. The alleged "suggestion" of *Bean* conveyed no *reasonable* expectation that a user could

Attorney Docket No.  
COE-566

PATENT APPLICATION  
Serial No. 10/715,430

Intuitively see that the top layer of *Dahlander* would be of the same material as the underlayment.

As to Examiner's rejection of Claim 6 as being unpatentable over *Dahlander* in view of *Burgess*, since Applicants have amended both Claims 1 and 6 (dependent on Claim 1) *Dahlander* no longer discloses the method of Appellants' Claim 1. The corrugated metal plates of *Burgess* were not adhered to an underlayment of concrete. There is no motivation offered by Examiner to combine *Burgess* with *Dahlander* to yield Applicants' invention as claimed in the amended claim set herein. The underlayment of *Burgess* is the corrugated steel, thus there is a structure comprising only two layers, each of a different material.

As to Claims 7 and 8, Claim 8 being dependent on Claim 7 amended herewith and Claim 7 being dependent on Claim 1 amended herewith, Applicants' arguments as above apply here also. Since Claim 1 has been amended herein, *Dahlander* no longer discloses the method of Applicants' Claim 1. Since all of the limitations of *Dahlander* are not met in Applicants' Claim 1 and Claims 7 and 8 depend from Claim 1, the 35 U.S.C § 103 rejection of *Dahlander* in view of *Schirmer* is inappropriate. *Schirmer* is cited for applying a sealant between overlapping edges of a sheet metal joint but there is no motivation or suggestion provided by Examiner for combining *Schirmer* with *Dahlander* to effect Applicants' invention since *Schirmer* would have had to provide the limitations missing from Applicants' Claim 1 as amended herein.

As to Claims 9 and 12, both being dependent on Claim 1 amended herein, Applicants' arguments as above apply here also. Since Claim 1 has been amended herewith, *Dahlander* no longer discloses the method of Applicants' Claim 1. Since all of the limitations of *Dahlander* are not met in Applicants' Claim 1 and Claims 9 and 12 depend from Claim 1, the 35 U.S.C § 103 rejection of *Dahlander* is inappropriate.

No new matter has been entered via this amendment. In view of the foregoing, Applicants respectfully request that the subject application be passed to issue as amended hereby with currently amended Claims 1, 2, 5 and 6, previously amended Claims 3, 7, 9 and 12, and original Claim 8, all claims now being in proper condition for allowance.

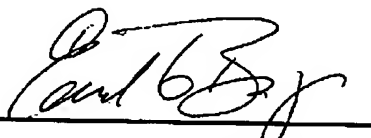
Attorney Docket No.  
COE-566

PATENT APPLICATION  
Serial No. 10/715,430

Respectfully Submitted,

5

U.S. Army Corps of Engineers  
Humphreys Engineer Center  
CEHEC-OC (Kingman Bldg.)  
10 7701 Telegraph Rd.  
Alexandria, VA 22315-3860  
505 342-3360

By:   
EARL H. BAUGHER, JR  
Attorney for Applicants  
Registration No. 40,905